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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,368	03/29/2001	Michimoto Sakai	Q63744	2711

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EXAMINER

RIES, LAURIE ANNE

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,368

Applicant(s)

SAKAI, MICHIMOTO

Examiner

Laurie Ries

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Page 2, line 8: "achieving" should read "achieve"

Page 2, line 18: "of" should read "for"

Page 5, line 15: the word "an" should be removed

Page 7, line 24: "attribute" should read "attributes"

Page 8, line 13: "form" should read "from"

Page 9, line 11: "fields" should read "field"

Page 14, line 17: "enabling" should read "enable"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Information critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 1 and 7-9 recite the limitation regarding a "subject document". While "subject document" is mentioned in the summary of the invention, it is not defined in such a manner as to enable one of ordinary skill in the art to effectuate this aspect of the disclosed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, in step d), it is unclear as to whether the "original information" specified refers to the "original locale information" as disclosed in step a), the "original item information" as disclosed in step b), or both. Also, in step c), the statement "subject locale information of the subject document" is vague and indefinite as a "subject document" is not defined within the application.

Claim 2 recites the limitation "item information" in line 15. There is insufficient antecedent basis for this limitation in the claim. For the purpose of further examination, it is assumed that "item information" refers to "original item information" as disclosed in claim 1.

Claim 3 recites the limitation "item information" in line 20. There is insufficient antecedent basis for this limitation in the claim. For the purpose of further examination,

it is assumed that "item information" refers to "original item information" as disclosed in claim 1.

Claim 5 recites the limitation "item information" in line 5. There is insufficient antecedent basis for this limitation in the claim. For the purpose of further examination, it is assumed that "item information" refers to "original item information" as disclosed in claim 1.

Claim 6 recites the limitation "item information" in line 14. There is insufficient antecedent basis for this limitation in the claim. For the purpose of further examination, it is assumed that "item information" refers to "original item information" as disclosed in claim 1.

Claim 6, step n) does not contain a verb specifying an action to be taken. For the purpose of further examination, it is assumed that step n) should read: "identifying subject format information of the original item information".

Claim 10 recites the limitation "item information" in line 4. There is insufficient antecedent basis for this limitation in the claim. For the purpose of further examination, it is assumed that "item information" refers to "original item information" as disclosed in claim 1.

Claim 10 also recites the limitation "converting device according to claim 1", however, claim 1 recites a "converting method".

Claim 12 recites "the step of". As claim 10 is a device limitation, the wording of this claim renders it indefinite.

Claim 13 recites "the step of". As claim 10 is a device limitation, the wording of this claim renders it indefinite.

The remaining dependent claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 7, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 7 recite a "converting method" which is an abstract idea not tangibly embodied in a computer readable/executable medium.

Claim 8 recites "means for" identifying original locale information. The means recited in this limitation are not defined in the disclosure as being tangibly embodied in a computer readable/executable medium.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,7-11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (U.S. Patent 6,157,905) in further view of Nakajima (U.S. Patent 5,550,741).

As per claim 1, Powell discloses a method to convert document data that includes identifying the original locale information of an original document (See Powell, Column 5, lines 10-12), identifying the original item information of the original document, in the form of character segments (See Powell, Column 13, lines 4-8), and determining a converting process based on the original location information and on subject location information of a subject document (See Powell, Column 4, lines 53-67). Powell does not disclose expressly that the method includes converting data contents of the original location and item information. Nakajima discloses a method of converting data contents of an original document from a first language to a second language based on the original location information and item information. (See Nakajima, Column 8, lines 13-26). Powell and Nakajima are analogous art because they are from the same field of endeavor of translating documents from one language to another. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the data conversion process of Nakajima with the language identification and conversion method formulation of Powell. The motivation for doing so would have been to efficiently produce a document translated from a first language to a second language once the identification of the first language had been determined. (See Nakajima, Column 5, lines 6-9). Therefore, it would have been obvious to combine Nakajima with

Powell for the benefit of producing a translated document to obtain the invention as specified in claim 1.

As per claim 3, Powell and Nakajima disclose the limitations of claim 1 as described above. Powell does not disclose expressly identifying the output location of the original item information to be used in the disclosed conversion process. Nakajima discloses identifying the output location information from the original document. (See Nakajima, Column 6, lines 14-20). Powell and Nakajima are analogous art because they are from the same field of endeavor of translating documents from one language to another. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the output location information of Nakajima with the conversion process of Powell. The motivation for doing so would have been to identify words previously translated that are repeated in the original document, thereby enhancing the efficiency of the conversion process. (See Nakajima, Column 6, lines 21-27). Therefore, it would have been obvious to combine Nakajima with Powell for the benefit of improving the language conversion process to obtain the invention as specified in claim 3.

Claim 7 is rejected on the same basis as claim 1.

As per claim 8, Powell also discloses a storage medium for the method as disclosed in claim 1. (See Powell, Figure 1).

Claim 9 is rejected on the same basis as claims 1 and 7.

Claim 10 is rejected on the same basis as claims 1 and 2.

Claim 11 is rejected on the same basis as claims 10 and 3.

Claim 14 is rejected on the same basis as claims 10 and 8.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (U.S. Patent 6,157,905) and Nakajima (U.S. Patent 5,550,741) as applied to claim 1 above, and further in view of Nagashima (U.S. Patent 5,157,606).

As per claim 2, Powell and Nakajima disclose the limitations of claim 1 as described above. Powell and Nakajima do not disclose expressly identifying item attribute information of the original item information to be used in the disclosed conversion process. Nagashima discloses that the attribute information of data are stored and used in the display process. Powell, Nakajima, and Nagashima are analogous art because they are from the same field of endeavor of translating documents from one language to another. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the attribute information of Nagashima with the conversion process of Powell and Nakajima. The motivation for doing so would have been to enhance the efficiency of the language identification and conversion process by reducing ambiguity and assisting in the identification of the language of the original document. (See Powell, Column 12, lines 56-67, and Column 13, lines 1-3). Therefore, it would have been obvious to combine Nagashima with Powell and Nakajima for the benefit of improving the language identification and conversion process to obtain the invention as specified in claim 2.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (U.S. Patent 6,157,905) and Nakajima (U.S. Patent 5,550,741) as applied to claim 1 above, and further in view of Kugimiya (U.S. Patent 5,587,902).

As per claim 4, Powell and Nakajima disclose the limitations of claim 1 as described above. Powell and Nakajima do not disclose expressly identifying formatting information of the original document to be used in the disclosed conversion process. Kugimiya discloses including format information in converting the document from a first language to a second language. (See Kugimiya, Column 2, lines 10-23). Powell, Nakajima, and Kugimiya are analogous art because they are from the same field of endeavor of translating documents from one language to another. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the formatting information of Kugimiya with the conversion process of Powell and Nakajima. The motivation for doing so would have been to improve the conversion process by allowing for a more efficient translation of the data in the original document. (See Kugimiya, Column 2, lines 21-23). Therefore, it would have been obvious to combine Kugimiya with Powell and Nakajima for the benefit of improving the language conversion process to obtain the invention as specified in claim 4.

Claim 12 is rejected on the same basis as claims 1, 4, and 10.

Claim 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (U.S. Patent 6,157,905) and Nakajima (U.S. Patent 5,550,741) as applied to claim 1 above, and further in view of Lakritz (U.S. Patent 6,623,529 B1).

As per claim 5, Powell and Nakajima disclose the limitations of claim 1 as described above. Powell and Nakajima do not disclose expressly identifying subject format information of the original item information to be used in the disclosed conversion process. Lakritz discloses the selection of subject matter quality level and other variables to be included in the translation process. (See Lakritz, Column 9, lines 64-67, and Column 10, lines 1-2). Powell, Nakajima, and Lakritz are analogous art because they are from the same field of endeavor of translating documents from one language to another. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the subject matter formatting information of Lakritz with the conversion process of Powell and Nakajima. The motivation for doing so would have been to provide the user with a suitable translated display using the formatting information appropriate for the given subject matter. (See Lakritz, Column 2, lines 29-34). Therefore, it would have been obvious to combine Lakritz with Powell and Nakajima for the benefit of improving the displayed translated document to obtain the invention as specified in claim 5.

Claim 13 is rejected on the same basis as claims 1, 5, and 10.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell, Nakajima and Nagashima as applied to claims 1 and 2 above, and further in view of Kugimiya and Latritz.

As per claim 6, the converting method is disclosed in the rejection of claims 1 and 2 as described above. The identification of output location information and

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conversion and output of data based on the same is disclosed in the rejection of claim 3 above. The identification of format information and conversion and output of data based on the same is disclosed in the rejection of claim 4 above. The identification of subject format information and conversion and output of data based on the same is disclosed in the rejection of claim 5 above.

Claim 15 is rejected on the same basis as claims 6 and 11.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is 703-605-1238. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER